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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/040,480	01/09/2002	Cheng-Chun Chang	BHT-3092-260	2899

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01/12/2006

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SUITE 1404
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FALLS CHURCH, VA 22041

EXAMINER

TO, BAOTRAN N

ART UNIT	PAPER NUMBER
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2135

DATE MAILED: 01/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/040,480	CHANG, CHENG-CHUN	
	Examiner	Art Unit	
	Bao Tran N. To	2135	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on October 24, 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-15 is/are pending in the application.
- 4a) Of the above claim(s) 1-7 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10/24/2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office action responds to the applicant's amendment filed on 10/24/2005. In this amendment, applicant canceled Claims 1-7 and added new Claims 8-15. Claims 8-15 remain for examination.

Response to Arguments

2. Applicant's arguments filed 10/24/2005 with respectfully to the rejections based on Tello, Liu and Sarat have been fully considered but they are not persuasive.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, Tello discloses a smart card reader is logically connected to the smart card reader interface which in turn is connected to the programming circuit and the microprocessor of the security engine. Tello further discloses a smart card is used for the identification and verification of authorized users and which control the level of access to a computer system by its containing cryptographic keys which are required

before any particular peripheral device will be enable (col. 14 lines 45-60). Liu discloses a mobile rack assembly for hard disk driver (abstract). Moreover, Sarat discloses the smart card operates in accordance with the USB protocol and can communicate directly with various peripheral devices by means of a USB connection, and provide more secure path for the transfer of personalized data, such as a password (col. 4, lines 25-30).

Therefore, the teachings of Tello, Liu and Sarat are combined to meet the claimed limitations. Tello Liu and Sarat do not need to disclose anything over and above the invention as claimed in order to render it unpatentable or anticipate. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claimed limitations.

In response to applicant's argument (from last paragraph of page 9 through page 11 in the Remark) that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

For the above reasons, it is believed that the rejections are maintained.

Claim Objections

3. Claim 15 is objected to because of the following informalities: the phrase "an IEEE 11394 receptacle" in line 2 should be --an IEEE 1394 receptacle---. Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 8-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tello (U.S. Patent 6,463,537 B1) in view of Liu (U.S. Patent 6,231,145 B1).

Regarding to claim 1, Tello discloses a data encipher/decipher system of a computer, comprising:

- a storage device (data storage devices) (col. 6, lines 25-26),
- a circuit board (motherboard) connected to a signal connector (col. 5, lines 10-11) and having:
 - a delay connector connected to the storage device (col. 6, lines 25-35);
 - a power plug connected to the storage device (col. 6, lines 25-35);
 - at least two connecting wires (col. 6, lines 25-35); and

a signal line (col. 6, lines 25-35);
an encipher/decipher device connected to the signal line of the circuit board (col. 14, lines 13-18 and 47-58),
an unlock receptacle being located in the exterior (col. 14, lines 47-48); and
an unlock key having an inner unlock chip and an unlock plug selectively engaging the unlock receptacle and being movable between engaged and disengaged positions (col. 14, lines 47-50);
wherein when the unlock key is in the engaged position the encipher/decipher device performs an identification procedure identifying a password in the inner unlock chip of the unlock key (col. 14, lines 45-55), when the password of the unlock key matches a password of the encipher/decipher device, the encipher/decipher device allows deciphered data and encrypted data to be read from and written to the storage device (col. , and when the unlock key is in the disengaged position, the encipher/decipher device performs the identification procedure and maintaining the storage device in a locked state (col. 4, lines 60-65 through col. 5, lines 15-50).

Tello discloses the limitations above, but fails to disclose "a portable rack". However, Tello expressly discloses that smart card (data storage) is read through a smart card reader. As shown in Fig. 1, the smart card would be inserted to the smart card reader. Nevertheless, Liu discloses the "Mobile Rack Assembly for Hard Disk Driver" invention, which includes the portable rack for easy access to the hard drive (col. 2, lines 48-53).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate Liu's invention with Tello to have the storage memory device portably connected to the computer. One of ordinary skill in the art would have been motivated to provide easy access to the storage device.

As per Claim 9, Tello and Liu disclose the limitations of Claim 8 above. Liu further discloses wherein the portable rack is a mobile rack including an outer rack mounted to a housing of the computer, and an inner rack electrically connected to the outer rack, the inner rack is removably inserted into a front gate of the outer rack (col. 1, lines 32-41).

As per Claim 10, Tello and Liu disclose the limitations of Claim 9 above. Tello further discloses wherein the storage devices is selected from a group of storage devices consisting of a hard disk, a zip disk drive, a magneto-optical disk drive, a tape unit and a card reader" (Tello, col. 20, lines 15-16).

As per Claim 11, Tello and Liu disclose the limitations of Claim 8 above. Liu further discloses wherein the portable rack is an external rack including an outer rack mounted to a housing of the computer, and an inner rack electrically connected to the outer rack, the inner rack is removably inserted into a front gate of the outer rack (col. 1, lines 32-41).

As per Claim 12, Tello and Liu disclose the limitations of Claim 11 above. Tello further discloses wherein the storage devices is selected from a group of storage devices consisting of a hard disk, a zip disk drive, a magneto-optical disk drive, a tape unit and a card reader (col. 20, lines 15-16).

As per Claim 13, Tello and Liu disclose the limitations of Claim 8 above. Tello further discloses comprising at least two signal lights located on the exterior of the portable rack and connected to the circuit board (col. 6, lines 55-59).

5. Claims 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tello in view of Liu, and further in view of Sarat (U.S. 6,581,122 B1).

As per Claim 14, Tello and Liu disclose the limitations of Claim 8 above.

However, Tello and Liu explicitly do not disclose "wherein the unlock receptacle is a USB receptacle and the unlock plug is a USB plug".

Nevertheless, Sarat discloses "Smart Card Which Operates With The USB Protocol" invention, which teaches a smart card device connected to the USB interface of the personal computer (col. 3, lines 60-67 and col. 4, lines 24-30).

Therefore, it would have been obvious at the time the invention was made for one having ordinary skill in the art to incorporate Sarat's USB Connecting Interface to the Smart Card in Tello and Liu's invention. One of ordinary skill in the art would have been motivated to provide a user friendly and fast interface to authenticate.

As per Claim 15, this claim has similar limitations as discussed in Claim 14 above. Thus, Claim 15 is also rejected with the same reasons as discussed in Claim 14 above.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

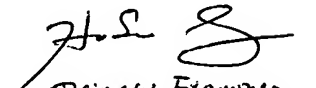
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bao Tran N. To whose telephone number is 571-272-8156. The examiner can normally be reached on Monday-Friday from 8:00 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Y. Vu can be reached on 571-272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2135

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Bao Tran To
12/29/2005


Primary Examiner
Art Unit 2135